

Interferences for such purpose.” (Emphasis added). The Examiner confirmed, during a telephone conference with Applicants’ attorney, that there is no remand by the Board for the purpose of submitting a supplemental examiner’s answer.

If the examiner feels that there are issues that still need to be addressed, “an examiner may (with supervisory patent examiner approval) respond to a reply brief by reopening prosecution.” See MPEP 1208.03. However, the Examiner has not provided any indication whatsoever that prosecution has been reopened.

Thus, Applicants request that the Examiner’s Supplemental Answer be removed from the file and not considered by the Board, or, in the alternative, that prosecution be reopened in this case.

In the event that the Board denies Applicants’ request as stated above, please consider the following remarks in response to the Examiner’s Supplemental Answer.

In the first paragraph of the Examiner’s Supplemental Answer, the Examiner is, again, attempting to manufacture a justification for combining the Ott ‘237 and Silber ‘154 patents. For example, the Examiner states that “[t]he trocar disclosed by Ott ‘237 is modified to include a grip layer to allow for good control of the trocar while maximizing comfort as taught by Silber ‘154.” See Supplemental Answer, p. 3.

The Ott patent and the present invention are directed to two entirely different aspects of a trocar assembly. The Ott patent is directed to a trocar device with a **safety shield** for the cutting tip. The emphasis of the Ott patent becomes overwhelmingly clear upon review of the abstract contained therein.

A safety trocar device is described which has an internal **safety shield** within the obturator of the trocar. The internal **safety shield** is spring loaded to extend in the distal

direction to cover the cutting tip of the trocar obturator. In one embodiment, the trocar obturator is made with a three-sided pyramidal cutting tip and the safety shield has three distally extending fingers which extend through openings in the faces of the pyramidal cutting tip. The safety shield with its three distally extending fingers is preferably rounded to an ellipsoidal shape on the distal end to facilitate penetration of the tissues and to reduce frictional resistance to deployment of the safety shield. The obturator and the safety shield are part of a trocar assembly which also includes a shaft and a proximal *handle*. Optionally, the trocar assembly may also include a safety locking mechanism which prevents premature or unintended withdrawal of the safety shield. The safety mechanism trocar can be used as a stand-alone trocar device or used in conjunction with an access cannula. The safety trocar is safer and more effective in use because the internal safety shield actuates to shield the sharp point of the obturator immediately upon penetrating the body tissue and entering a body cavity.

As seen above, the Abstract of the Ott patent includes a reference to a safety shield in all but one sentence (8 total references), while there is just one passing reference to a handle. In the field of the invention, Ott states that the patent “relates to a surgical trocar which has an internal safety shield...”. (Emphasis added).

With regard to the Silber patent, there are two issues that must be addressed by the Examiner to establish that this patent qualifies as relevant prior art with respect to the patentability of present invention. The first issue is to determine whether the reference actually discloses an element recited in the claims of the present invention. The second issue is to determine whether it is proper to combine the Silber patent with the Ott patent to render one or more of the claims of the present invention obvious. See MPEP 706.02(j).

Regarding the first issue, the Examiner erroneously takes language, in isolation, from the Silber patent in an attempt to support the argument that a “cushioning member”

is disclosed. That is, while Silber discloses a rigid grip layer throughout the patent, the Examiner is attempting to exploit a single reference in the patent to a “substantially rigid” grip layer. The reason that Silber coats the handle with a grip layer is to provide a higher coefficient of friction so that the “sonographer [can] maintain control over the ultrasound probe during ... imaging procedures while applying minimal gripping forces.” See Silber, col. 3, lines 20-24 (emphasis added). Minimal gripping forces require friction for enhanced control, not cushioning. To infer that Silber’s coating layer has an inherent “cushioning member”, it must be clear that the missing descriptive matter is necessarily present in the provided description. Silber entirely lacks descriptive matter on a cushioning member for a hand grip.

Despite the Examiner’s contention that Silber’s coating may be defined as resilient, and therefore have cushioning features, the specification of Silber does not support this position. More specifically, the term “rigid”, which is used in the Silber specification to describe the coating, is actually an antonym for the term “resilient”, which is the term that the Examiner desires to use to describe the coating in Silber. Accordingly, Silber deliberately teaches away by providing a thin, **rigid** coating.

Regarding the second issue, the Examiner previously acknowledged the fact that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

However, the Examiner still fails to cite a specific example wherein Silber provides the necessary teaching, suggestion, or motivation to combine the references.

There exists no motivation or incentive to attempt to combine the two references as one. Such an attempt is done in hindsight erroneously.

Ott is directed to a specific feature of a trocar – a safety shield. Silber is directed to an ultrasound probe housing with a reduced control pressure grip. As discussed herein and in the Appeal Brief, the recitation of the features of the Ott patent, as well as the recitation of the features of the Silber patent, illustrates the fact that these two patents have opposing goals and, therefore, there is no suggestion or incentive to combine these two patents.

In view of the foregoing remarks and those included in the Brief on Appeal filed September 3, 2003 and the Reply Brief filed February 2, 2004, Appellants respectfully submit that all of the claims now pending in this application, namely Claims 1-10, are in condition for allowance. Early and favorable reconsideration of this application is respectfully requested.

Respectfully submitted,



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